

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 1

Filed by: Fred E. McKelvey  
Senior Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-308-7953

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

MAR 12 1997

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

JERROLD OLEFSKY, TAMMY ANTONUCCI, DEAN LOCKWOOD  
and REBECCA NORRIS,

Junior Party,

v.

RICHARD M. HINDLEY and MICHAEL A. CAWTHORNE,

Senior Party.

Patent Interference No. 103,822

**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, counts and claims designated to correspond to the count appear in an "Attachment" to this order.

Judge designated to handle the interference

Senior Administrative Patent Judge Fred E. McKelvey has been designated to handle the interference. 37 CFR § 1.610.

Telephone Conference Calls

Any questions regarding this interference may be made to my office via conference call (703-308-9797) in which counsel for all parties must participate. It is not my practice to accept telephone calls from one counsel--even on so-called procedural matters.

Conference calls may be arranged through one of the three administrators who work at the Board of Patent Appeals and Interferences (hereinafter referred to as the "board"). Those individuals are (1) Amalia Santiago, (2) Merrell C. Cashion, Jr., and (3) Dale M. Shaw. They can be reached at 703-308-9797. Counsel for the parties are advised that I am normally scheduled to work in the office on Tuesdays and Wednesdays and that I am readily available for conference calls. Moreover, on days on which I am not scheduled to be in the office, counsel should feel free to contact an administrator. I am generally available for conference calls. I can also be reached on the Internet at fmckelvey@aol.com.

Counsel are not to contact another administrative patent judge in connection with this interference unless first authorized by an administrator.

Delivery of papers to the Patent and Trademark Office

The parties may use the U.S. Postal Service to send papers and other materials related to this interference to the Patent and Trademark Office (PTO). When using the U.S. Postal Service, please use the following address:

BOX INTERFERENCE  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231.

The parties may also hand deliver papers and other material to the PTO. I encourage hand-delivery of papers. Hand-delivery should be to the following address:

Board of Patent Appeals and Interferences  
Crystal Gateway 2  
1225 Jefferson Davis Highway  
10th Floor  
Arlington, Virginia 22202

The address to use in the case of a commercial one-day delivery service (i.e., Federal Express) is the board's Crystal Gateway address.

Hand-delivery directly to the board will (1) minimize the time it takes for a paper or other material to reach me and (2) allow me to render prompt decisions on matters presented to me.

The parties may also forward relatively short papers to the board via fax at 703-308-7953. If a paper is forwarded by fax, it is not necessary to file a confirmation copy.

Requirement for filing two copies of each paper

When presenting a paper in this interference, each party is required to submit (1) an original and (2) one copy of each paper, the copy shall be marked at the top:

"COPY FOR JUDGE"

Notice under 35 U.S.C. § 135(c)

Notice is hereby given of the requirement of 35 U.S.C. § 135(c) for filing in the PTO a copy of any agreement "in connection with or in contemplation of the termination of the interference." See Unisys Corp. v. Commissioner of Patents and Trademarks, 39 USPQ2d 1842 (D.D.C. 1993).

Lead and backup counsel

On or before **March 26, 1997**, each party is required to identify in a separate paper a lead counsel and a backup counsel for lead counsel, as well as the mailing address, telephone numbers, fax number and internet address (if there is an internet address) for both lead counsel and backup counsel (37 CFR § 1.613(a)). If counsel's address is a Post Office Box, please supply a non-postal box address where Federal Express may be sent by opposing counsel and/or the Patent Office.

Lead counsel and/or backup counsel should file a power of attorney in their client's application or patent files if not already of record under 37 CFR § 1.34(b).

#### Notification of entry of orders via the internet

Although all orders entered in this interference are sent to counsel in paper form via mail, fax or Federal Express (as appropriate), I am also willing to forward copies of orders via the internet.

Counsel wishing to receive copies of orders via the internet may supply an E-Mail address as part of the paper identifying lead and backup lead counsel.

I have found that documents formatted in WordPerfect 5.1 (DOS) can be attached to an E-Mail message and downloaded when sent via the internet. An attachment document would be sent via the internet at the same time the paper copy of the document is placed in the board's outgoing mail box.

#### Real party in interest

On or before **March 26, 1997**, each party shall notify the board in a separate paper of any and all right, title, and interest in any application or patent involved in the interference (37 CFR § 1.602(b)).

All parties are obligated to continually and promptly update changes of the real party in interest.

#### Size of paper

All papers (e.g., identification of lead counsel, identification of real party in interest, motions, preliminary motions, preliminary statements, briefs, etc.) filed in this interference shall be (1) 8½ x 11 inch paper or (2) A4, with the

possible exception of original exhibits. Papers of a different size (e.g., legal size) shall not be filed.

#### Holes at the top of papers

All papers filed in this interference shall have two holes punched at the top spaced at 2-3/4 inches apart (each hole spaced equidistant from an imaginary center line running from the top to the bottom of the paper) so that the papers may be placed in interference files maintained by the PTO.

#### Prohibition against presenting duplicate papers

When presenting a paper in this interference, counsel shall not submit with the paper (as an appendix, exhibit, or otherwise) a copy of a paper previously filed in the interference (37 CFR § 1.618(b)).

#### Citation of case law in papers

When citing a decision of a court which is published in the West Reporter System and the USPQ, counsel should provide parallel citations, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

Binding precedent is the following:

- (1) Decisions of the U.S. Supreme Court.
- (2) Decisions of the Court of Appeals for the Federal Circuit, the former CCPA and the former Court of Claims. See South Corp. v. United States, 690 F.2d 1368, 1370-71, 215 USPQ 657, 657-58 (Fed. Cir. 1982) (en banc), and In re Gosteli,

872 F.2d 1008, 1011, 10 USPQ2d 1614, 1616-17 (Fed. Cir. 1989) (where there is a conflict between two or more decisions of the former CCPA, the later CCPA decision controls).

(3) Decisions of the Commissioner of Patents and Trademarks.

(4) Decisions of the Board of Patent Appeals and Interferences which have been determined to be binding precedent under the board's Standard Operating Procedure 94-02. See, e.g., Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995).

Decisions of the regional courts of appeals and the district courts may be cited, but are not binding precedent.

Non-precedential decisions of federal courts shall not be cited.

Non-precedential decisions of the board may be cited, but are not binding.

The Manual of Patent Examining Procedure (MPEP) is a guide for patent examiners which is prepared by the Office of the Assistant Commissioner for Patents. The MPEP contains Chapter 2300 on interference practice. Chapter 2300 is often out of date with respect to interference law and practice. Hence, Chapter 2300 of the MPEP is not to be cited in papers filed in this interference. Counsel should instead cite only primary authority: the United States Code (USC), the Code of Federal Regulations (CFR), notices published in the Federal Register and/or Official Gazette, and binding precedent.

Copies of application/patent files

The parties to the interference have access to the patent and application files involved in the interference, as well as any benefit file identified in this notice. 37 CFR § 1.612(a).

A party may order an uncertified copy of an application and/or patent file from the PTO. In an effort to insure that a request by a party for a copy of a file is not delayed, the following procedure is established in this interference for ordering copies.

On or before **March 26, 1997**, any party wishing a copy of a file of any application and/or patent identified in this notice shall file a request for the copy with the Clerk's Office of the board directed to my attention. The request must reach the board (not the Mail Room of the PTO) by **March 26, 1997**, and must be accompanied with authorization to charge any applicable fee to a deposit account. The request must also be accompanied by any necessary power of attorney. On or before **March 28, 1997**, the files and any requests will be forwarded to the Dissemination Support Division, Patent and Trademark Copy Sales of the PTO, where copies will be made. My understanding is that copies will be made and mailed within ten (10) days of receipt by the Dissemination Support Division. If a party does not receive a copy of a requested file within the time frames set out herein, I request that I be advised by fax of the non-receipt. Orders for files will be closely monitored by personnel at the Board of



Patent Appeals and Interferences with the view of insuring that orders are timely filed.

The board will not release any application or patent file mentioned in this notice to the Dissemination Support Division or any other unit of the PTO for any purpose prior to **March 28, 1997.**<sup>1</sup>

Service of papers by hand or Express Mail

All papers served on opposing counsel in this interference shall be served by Express Mail (a one-day delivery service of the U.S. Postal Service) (37 CFR § 1.646(d)); alternatively counsel may serve opposing counsel using any means which accomplishes a one-day delivery, e.g., by hand, fax, or a commercial one-day delivery service.

Conference call to set dates

After proceedings on the **ORDER UNDER 37 CFR § 1.641** (Paper No. 3) entered concurrently herewith, a telephone conference call will be set to discuss dates for filing preliminary statements and preliminary motions and for taking such other action as may be appropriate.

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<sup>1</sup> Theoretically, it is also possible for files to be ordered directly from the Dissemination Service Division by filing a request addressed to U.S. Patent and Trademark Office, Box 9 (ATTN: DSD), Washington, D.C. 20231. The board will not monitor the progress of orders made directly to the above address or directly to DSD. Furthermore, no request for an extension of time based on non-receipt of a request to the PTO for a copy of a file will be considered or granted unless the procedure set out in this order has been followed, i.e., the files are ordered through the board as set out in the body of this notice.

For the convenience of counsel, a copy of a "sample" order relating to the filing of preliminary motions (and related materials) and preliminary statements accompanies this notice. Counsel are encouraged to discuss the order by phone prior to the telephone conference call.

Headings to be used on papers filed in the interference

In all papers filed with the board in this interference on behalf of a party, the heading shown in the attached Appendix shall be used.

Notification to the board of receipt of this notice

Counsel for each party is requested to promptly advise me by letter that the notice declaring the interference was received.

Copies of patents and literature mentioned in each specification (and translations, if available)

On or before **April 8, 1997**, each party:

(1) shall serve on all opponents a legible copy of every patent and literature reference (and in the case of patents or literature in a foreign language, a translation, if available) mentioned in the specification of the party's involved patent and/or application, and

(2) shall file in the PTO a notice (without copies of the patents or literature) that it has served the patents and literature as ordered herein.

Copy of specification/claims in electronic form

On or before **April 8, 1997**, each party is requested to file with the judge assigned to this interference a computer 3½ inch high density floppy disk containing in a first document on the disk a copy of the party's specification, and in a second document on the disk a clean copy of the party's claims as currently worded (for use in an IBM compatible computer in WordPerfect 5.1 (DOS), Microsoft Word 6.0 (Windows) or ASCII format (preferably WordPerfect 5.1 (DOS))).

Time to respond to motions under 37 CFR § 1.635

The time for filing an opposition to a motion under 37 CFR § 1.635 is hereby set to be five (5) working days after service of the motion. 37 CFR § 1.638(a).

The time for filing a reply to an opposition to a motion under 37 CFR § 1.635 is hereby set to be three (3) working days after service of the opposition. 37 CFR § 1.638(b).

A motion under 37 CFR § 1.635 may be denied prior receipt of an opposition. A motion under 37 CFR § 1.635 may be granted after an opposition is filed and prior to receipt of a reply.

Comments on requests for extensions of time

The parties are advised that I set times with the view to rendering prompt and timely decisions. Thus, in setting times in this interference, I have taken into account decisions which need to be rendered in this case, as well as other cases. It is true that requests for extension of time are authorized by 37 CFR

§ 1.645. But, Rule 645 requires a showing of "good cause." Whatever counsel's experience may be in other PTO matters or courts generally, my standard of what constitutes "good cause" is considerably high.

There are few, if any, circumstances where "good cause" can be based on the press of other business arising after a time is set by an order entered in this interference, particularly where a time period is set after conference with counsel. Thus, a matter in another case (i.e., argument or a trial) or an event (i.e., a deposition, client meeting in the U.S. or abroad) scheduled or ordered after a conference call, in which a time is set in this interference, normally will not constitute the press of other business.

Generally, I do not consider an attempt to settle "good cause." While I encourage settlement, and am available to assist in settlement efforts where appropriate, it is my rather firm policy--subject to few, if any, exceptions--that the parties can either settle or meet the next pending deadline.

*Fred McKelvey*

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FRED E. McKELVEY  
Senior Administrative Patent Judge

Attachment  
(37 CFR § 1.611(c))

The parties involved in this interference are:

Junior Party

Named inventors: Jerrold Olefsky, Solano Beach, CA  
Tammy Antonucci, Mequon, WI  
Dean Lockwood, Ann Arbor, MI  
Rebecca Norris, Kewadin, MI

Patent: U.S. Patent N<sup>o</sup> 5,478,852,  
granted December 26, 1995,  
based on application 08/293,899,  
filed August 23, 1994

Title: Use of thiazolidinedione derivatives and  
related antihyperglycemic agents in the  
treatment of impaired glucose tolerance in  
order to prevent or delay the onset of  
noninsulin-dependent diabetes mellitus

Assignee: Sankyo Company, Limited

Attorneys: FRISHAUF, HOLTZ, GOODMAN & WOODWARD, P.C.

Accorded Benefit: U.S. application 08/122,251,  
filed September 15, 1993

Address: FRISHAUF, HOLTZ, GOODMAN & WOODWARD, P.C.  
767 Third Avenue -- 25th Floor  
New York, NY 10017-2023

Senior Party

Named Inventors: Richard M. Hindley, Epsom, England  
Michael A. Cawthorne, Epsom, England

Application: Application 08/458,033,  
filed June 1, 1995

Title: Novel compounds

Assignee: None

Attorneys: HOPGOOD, CALIMAFDE, KALIL & JUDLOWE

Accorded Benefit: U.S. application 08/358,327,  
filed December 19, 1994

U.S. application 08/053,997,  
filed April 26, 1993

U.S. application 07/641,474,  
filed January 15, 1991,  
now U.S. Patent N<sup>o</sup> 5,232,925,  
granted August 3, 1993

U.S. application 07/457,272,  
filed December 27, 1989,  
now U.S. Patent N<sup>o</sup> 5,002,953,  
granted March 26, 1991

U.S. application 07/238,764,  
filed August 30, 1988

Address: HOPGOOD, CALIMAFDE, KALIL & JUDLOWE  
60 East 42nd Street  
New York, NY 10165

Count 1<sup>2</sup>

A method according to claim 23 of the Olefsky '852 patent,  
or  
a method according to claim 16 of Hindley '033 application.

The claims of the parties which correspond to count 1 are:

Olefsky '852:	23
Hindley '033:	16

The claims of the parties which do not correspond to count 1  
are:

Olefsky '852:	1-22
Hindley '033:	1-13

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<sup>2</sup> For an explanation of why Count 1 differs from the count proposed by the Primary Examiner and why the claims designated to correspond to the count differ from those suggested by the Primary Examiner, see Paper No. 2, entered concurrently herewith.

Appendix

Paper No. \_\_\_\_\_

Filed on behalf of: Party \_\_\_\_\_  
By: Name of lead counsel, Esq.  
Name of backup counsel, Esq.  
Street address  
City, State, and Zip-Code  
Tel:  
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Senior Administrative Patent Judge Fred E. McKelvey)

\_\_\_\_\_  
JERROLD OLEFSKY, TAMMY ANTONUCCI, DEAN LOCKWOOD  
and REBECCA NORRIS,

Junior Party,

v.

RICHARD M. HINDLEY and MICHAEL A. CAWTHORNE,

Senior Party.

\_\_\_\_\_  
Patent Interference No. 103,822

\_\_\_\_\_  
TITLE OF PAPER



cc (via Federal Express):

Attorneys for Olefsky:

FRISHAUF, HOLTZ, GOODMAN & WOODWARD, P.C.  
767 Third Avenue -- 25th Floor  
New York, NY 10017-2023

Attorneys for Hindley:

HOPGOOD, CALIMAFDE, KALIL & JUDLOWE  
60 East 42nd Street  
New York, NY 10165

Charles M. Kinzig, Esq.  
SMITHKLINE BEECHAM CORPORATION  
Corporate Intellectual Property - US, UW2220  
709 Swedeland Road  
King of Prussia, PA 19406-0939

Enc. Sample Order relating to the filing of preliminary motions  
(and related materials) and preliminary statements

Copy of PTO Form 850

Copy of specification, original claims 1-13 and Paper  
Nos. 7, 8, 9 and 10 of Hindley '033

Paper No. 20 of Hindley'327;

U.S. Patent N<sup>o</sup> 5,478,852 to Olefsky;

U.S. Patent N<sup>o</sup> 5,002,953 to Hindley;

U.S. Patent N<sup>o</sup> 5,232,925 to Hindley;

U.S. Patent N<sup>o</sup> 5,521,201 to Hindley; and

Copy 319 New England Journal of Medicine 1500-1506  
(Dec. 5, 1988).

## INTERFERENCE INITIAL MEMORANDUM

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 2 parties

PARTY Olefsky et al.	SERIAL NO. 239,899	FILING DATE 8-23-94	PATENT NO., IF ANY 5,478,852	ISSUE DATE, IF ANY 12-26-95
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If application has been patented, have maintenance fees been paid?

Yes

No

☒ Maintenance fees not due yet

If accorded the benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY

The claim(s) of this party which correspond(s) to this count is(are):

PATENTABLE CLAIMS

23-27

UNPATENTABLE CLAIMS

The claim(s) of this party which does(do) not correspond to this count is(are):

PATENTABLE CLAIMS

1-22

UNPATENTABLE CLAIMS

PARTY Hindley et al.	SERIAL NO. 458,033	FILING DATE 6-1-95	PATENT NO., IF ANY	ISSUE DATE, IF ANY
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If application has been patented, have maintenance fees been paid?

Yes

No

☐ Maintenance fees not due yet

If accorded the benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
U.S.	358,327	12-19-94		
U.S.	053,997	4-26-93		
U.S.	641,474	1-15-91	5,232,925	8-3-93
U.S.	457,272	12-27-89	5,002,953	3-26-91

The claim(s) of this party which correspond(s) to this count is(are):

PATENTABLE CLAIMS

14 and 15

UNPATENTABLE CLAIMS

The claim(s) of this party which does(do) not correspond to this count is(are):

PATENTABLE CLAIMS

1-13

UNPATENTABLE CLAIMS

## Instructions

- For every patent involved in the interference, check if the fees have been paid by contacting the MAINTENANCE FEE DEPARTMENT at 308-5069. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 USC 135(a); 37 CFR 1.606).
  - For each party, separately identify the patentable and unpatentable claims which correspond to the count. (37 CFR 1.601 (f), 1.601 (n), 1.609(b)(2)).
  - For each party, separately identify the patentable and unpatentable claims which do not correspond to the count (37 CFR 1.609(b)(3)).
  - Forward all files including those the benefit of which is being accorded.
  - Keep a copy of the Interference Initial Memorandum and any attachments for your records.
- All information requested below must be attached on (a) separate sheet(s) and type-written.
- On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.
  - For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).
  - For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).
  - For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

TE	PRIMARY EXAMINER (Signature)	TELEPHONE NO.	ART UNIT
		308-4531	1201
	GROUP DIRECTOR SIGNATURE (if required)		

Number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest intervening applications necessary for continuity.

1. AGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

## ATTACHMENT TO INTERFERENCE-INITIAL MEMORANDUM

### 6. Proposed Count

A method of treating impaired glucose tolerance comprising administering to a host suffering therefrom a therapeutically effective amount of a compound selected from the group consisting of 5-(4-(2-(N-methyl-N-(2-pyridyl)amino)ethoxy)benzyl)-2,4-thiazolidinedione and 5-(4-(2-(N-methyl-N-(2-pyrimidinyl)amino)ethoxy)benzyl)-2,4-thiazolidinedione.

OR

A method of treating impaired glucose tolerance to prevent or delay the onset of noninsulin-dependent diabetes mellitus comprising administering to a host suffering therefrom a therapeutically effective amount of a compound consisting of

(+)-5-[[4-(3,4-dihydro-6-hydroxy-2,5,7,8-tetramethyl-2H-1-benzopyran-2-yl)methoxy]phenyl]methyl]-2,4-thiazolidinedione: (troglitazone);

4-(2-naphthylmethyl)-1,2,3,5-oxathiadiazole-2-oxide;

5-[4[2-[N-(benzoxazol-2-yl)-N-methylamino]ethoxy]benzyl]-5-methylthiazolidine-2,4-dione;

5-[4-[2-[2,4-dioxo-5-phenylthiazolidin-3-yl]ethoxyl]benzyl] thiazolidine-2,4-dione;

5-[4-[2-[N-methyl-N-(phenoxycarbonyl)amino]ethoxy]benzyl] thiazolidine-2,4-dione;

5-[4-(2-phenoxyethoxy)benzyl]thiazolidine-2,4-dione;

5-[4-[2-(4-chlorophenyl)ethylsulfonyl]benzyl] thiazolidine-2,4-dione;

5-[4-[3-(5-methyl-2-phenyloxazol-4-yl)propionyl]benzyl] thiazolidine-2,4-dione;

5-[4-[(1-methylcyclohexyl)methoxy]benzyl]thiadiazolidine-2,4-dione; (ciglitazone);

5-[4-(3-hydroxy-1-methylcyclohexyl)methoxy]benzyl] thiadiazolidine-2,4-dione;

5-[4-[2-(5-methyl-2-phenyloxazol-4-yl)ethoxyl]benzyl]thiadiazolidine-2,4-dione;

5-[4-[2-(5-ethylpyridin-2-yl)ethoxyl]benzyl]thiadiazolidine-2,4-dione; (pioglitazone);

5-[(2-benzyl-2,3-dihydrobenzopyran)-5-ylmethyl]thiadiazoline-2,4-dione; (englitazone);

5-[[2-(2-naphthylmethyl)benzoxazol]-5-ylmethyl]thiadiazoline-2,4-dione;

5-[4-[2-(3-phenylureido)ethoxy]benzyl]thiadiazoline-2,4-dione;  
5-[4-[2-[N-(benzoxazol-2-yl)-N-methylamino]ethoxy]benzyl]thiadiazoline-2,4-dione;  
5-[4-[3-(5-methyl-2-phenyloxazol-4-yl)propionyl]benzyl]thiadiazoline-2,4-dione;  
5-[2-(5-methyl-2-phenyloxazol-4-ylmethyl)benzofuran-5-ylmethyl]-oxazolidine-2,4-dione;  
5-[4-[2-[N-methyl-N-(2-pyridyl)amino]ethoxy]benzyl]thiazolidine-2,4-dione; and  
5-[4-[2-[N-(benzoxazol-2-yl)-N-methylamino]ethoxy]benzyl]-oxazolidine-2,4-dione.

7. Claims Corresponding To The Count

Claims 14 and 15 of application Serial No. 458,033 both relate to the use of the compound 5-(4-(2-N-methyl-N-(2-pyridyl)amino)ethoxy)benzyl)-2,4-thiazolidinedione for the treatment of IGT. Claim 14 is identical to the portion of the count which precedes the word "OR."

Claim 23 relates to a genus of compounds which are useful for treating IGT. Claim 23 is identical to the portion of the count which follows the word "OR." This genus specifically includes 5-(4-(2-N-methyl-N-(2-pyridyl)amino)ethoxy)benzyl)-2,4-thiazolidinedione (which is a compound included in claims 14 and 15 of application Serial No. 458,033). Claims 24-27 are all subgeneric to claim 23, and are directed to the first, twelfth, thirteenth and nineteenth compounds, respectively, of claim 23.

8. Claims Not Corresponding To The Count

The interfering subject matter resides in the use of compounds as defined in claims 14 and 15 of application Serial No. 458,033 to treat IGT. Claims 1-13 of application Serial No. 458,033 do not relate to the use of compounds to treat IGT.

Claims 1-22 of Patent No. 5,478,852 do not involve the use of the compounds of claims 14 or 15 of application Serial No. 458,033.

Prior applications the Party Hindley et al. is accorded benefit of:

<u>Country</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No., if any</u>
U.S.	358,327	12-19-94	
U.S.	053,997	4-26-93	
U.S.	641,474	1-15-91	5,232,925
U.S.	457,272	12-27-89	5,002,953
U.S.	238,764	8-30-88	
GB	8802454	2-4-88	

Prior applications the party Olefsky is accorded benefit of:

<u>Country</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No., if any</u>
U.S.	293,899	8-23-94	5,478,852

## INTERFERENCE DIGEST

Interference No. 103,822 Paper No. 12  
Name, Richard M. Hindley et al.  
Serial No. 08/458,033 Patent No. \_\_\_\_\_  
Title, NOVEL COMPOUNDS  
Filed, 06/01/95  
Interference with Olefsky et al.  
\_\_\_\_\_  
\_\_\_\_\_

## DECISION ON MOTIONS

Examiner-in-Chief, \_\_\_\_\_ Dated, \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

## FINAL DECISION

Board of Patent Appeals and Interferences, Adverse Dated, 6-30-98  
Court, BPAI Dated, 6-30-98

## REMARKS

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

This should be placed in each application or patent involved in interference in addition to the interference letters.